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| APPLICATION NO.                                                                                  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/812,680                                                                                       | 03/30/2004  | David C. Boyer       | 02274/6622AUS       | 4028             |
| 20879                                                                                            | 7590        | 12/29/2005           | EXAMINER            |                  |
| EMCH, SCHAFER, SCHAUB & PORCELLO CO<br>P O BOX 916<br>ONE SEAGATE SUITE 1980<br>TOLEDO, OH 43697 |             |                      | BRUNSMAN, DAVID M   |                  |
|                                                                                                  |             |                      | ART UNIT            | PAPER NUMBER     |
|                                                                                                  |             |                      | 1755                |                  |

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/812,680 | <b>Applicant(s)</b><br>BOYER ET AL. |  |
|                              | <b>Examiner</b><br>David M. Brunsman | <b>Art Unit</b><br>1755             |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 5, 6, 8-11, 13 and 14 is/are allowed.
- 6) ☒ Claim(s) 4, 7, 12, 15 and 16 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. <u>20051209</u> .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20040628</u> .                                                            | 6) <input type="checkbox"/> Other: ____.                                    |

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This action replaces the Requirement for Restriction mailed 06 December 2005.

Please disregard that office communication.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 7, 12 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 includes unnecessary incorporation by reference to Table 1 of the specification. It should be rewritten to complete in itself.

#### **2173.05(s) Reference to Figures or Tables**

Where possible, claims are to be complete in themselves. Incorporation by reference to a specific figure or table "is permitted only in exceptional circumstances where there is no practical way to define the invention in words and where it is more concise to incorporate by reference than duplicating a drawing or table into the claim. Incorporation by reference is a necessity doctrine, not for applicant's convenience." *Ex parte Fressola*, 27 USPQ2d 1608, 1609 (Bd. Pat. App. & Inter. 1993) (citations omitted).

Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. See MPEP § 608.01(m).

Claim 7 lacks antecedent basis in the base claim for "driveway sealer". The verb "exhibit" also fails to agree with the subject. Claim 12 lacks antecedent basis for "binder" in the base claim. Claim 15 fails to set forth the conditions at which the Brookfield viscosity is measured.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 15-16 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for inventions wherein the anti-wear agent comprises aliphatic carboxylic acids and aliphatic polyamines, does not reasonably provide enablement for those wherein the anti-wear agent is any antistripping agent. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The patentability of the instant invention relies on a finding that it would not have been obvious to one of ordinary skill in the art to use any known asphalt antistripping agent (in general) as an anti-wear agent in a pitch based sealer or sealer base. For this to hold, the effect on the antiwear properties of any particular antistripping agent must not be predictable. The instant specification specifically discloses only a single agent, aliphatic carboxylic acids and aliphatic polyamines, as effective and fails to teach one of ordinary skill in the art which other antistripping agent are effective as anti-wear agent in pitch-based sealers.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the

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applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6383365.

The reference teaches a driveway sealing emulsion (Column 4, lines 44-50) comprising water, clay, emulsifier and a pitch-based sealer base comprising a cutback oil/pitch blend softening at 44-48 C (see examples) that is produced by combining a cutback solvent and a 115 C softening point pitch. Column 5, lines 39-54 teach addition of an organic amine antistripping agent to the sealer composition to promote coating and adhesion. It would have been obvious to one of ordinary skill in the art to add a known antistripping agent to the exemplary compositions of the reference because it teaches they would be expected to improve coating and adhesion. More fundamentally, it would have been obvious on its face to add an "anti-wear agent" to a sealer composition to improve wear characteristics by the very meaning of the term "anti-wear agent".

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6267809.

Claim 4 of the reference teaches a driveway sealer emulsion comprising water, clay, emulsifier and a pitch component softening below 50 C, the pitch component comprising a blend of a pitch softening at over 100 C and aromatic cutback oil. Column 5, lines 36-48 teach addition of an amine antistripping agent to the sealer composition to promote coating and adhesion. It would have been obvious to one of ordinary skill in the art to add a known antistripping agent to the exemplary compositions of the reference because it teaches they would be expected to promote coating and adhesion. More fundamentally, it would have been obvious on its face to add an "anti-wear agent" to a sealer composition to improve wear characteristics by the very meaning of the term "anti-wear agent".

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The instant specification provides convincing evidence that use of an anti-wear agent comprising aliphatic carboxylic acids and aliphatic polyamines (PAVE 192, for example) provides unexpectedly improved wear characteristics to sealer bases and the sealer emulsions comprising them. The evidence of the specification is not commensurate in scope with claims 15 and 16. In fact, evidence that any known antistripping agent would produce similarly improved wear characteristics would undermine the patentability of the instant claims as the addition of antistripping agent in general is explicitly taught by the prior art of record.

Claims 4, 7 and 12 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-3, 5, 6, 8-11, 13 and 14 are allowable over the prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunsman whose telephone number is 571-272-1365. The examiner can normally be reached on M, W, F, Sa; 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David M Brunzman  
Primary Examiner  
Art Unit 1755

DMB

A handwritten signature in black ink, appearing to read 'David M Brunzman', with a long horizontal stroke extending to the right.